



PATENT
Attorney Docket No. 05725.1011-00000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	
)	
Daniela GIACCHETTI)	Group Art Unit: 3628
)	
Application No.: 10/024,482)	Examiner: Igor N. Borissov
)	
Filed: December 21, 2001)	
)	Confirmation No.: 4566
For: BODY IMAGE TEMPLATES WITH)	
PRE-APPLIED BEAUTY)	
PRODUCTS)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Appellant submits this Reply Brief under 37 C.F.R. § 41.41 to the Board of Patent Appeals and Interferences ("the Board"), from the August 24, 2007 Examiner's Answer in this case.

Response to New Arguments Set Forth in the Examiner's Answer

The Examiner has altered his arguments in a manner that differs from his prior assertions in this case, particularly with regard to the rejections under 35 U.S.C. §§ 101 and 102(e). Appellant respectfully submits the following remarks in response to the Examiner's new arguments.

The rejection of claim 1 under 35 U.S.C. § 101 should be reversed.

On page 6 of the Examiner's Answer, the Examiner alleges that claim 1 is purportedly directed to non-statutory subject matter because

claim 1 does not recite any electrical, chemical, or mechanical acts or results, typical in traditional process claims; the claim does not require any machine or apparatus to perform the recited steps; and, finally, the claim does not provide any physical transformation of an article to a different state or thing, nor does it require any transformation of data or signals.

The Examiner further alleges that, because

claim 1 does not require any machine or apparatus to perform the recited steps, and does not require implementing a mathematical formula or algorithm to transform data, the information recited in the claim does not represent a real world activity such as found in Arrhythmia, Alappat,¹ or State Street.

Answer at 7. The Examiner concludes that, therefore, "claim 1 falls outside the scope of § 101 as failing to produce a useful and concrete and tangible result." Id.

Appellant respectfully submits that claim 1 is, in fact, directed to statutory subject matter under § 101. The Examiner continues to misconstrue the terms "facilitating" and "enabling," in claim 1. The Examiner correctly identifies explanations of these terms in

¹ Although citations have been omitted, it appears that the Examiner is referring to Arrhythmia Research Technology Inc. v. Corazonix Corp., 958 F.2d 1053 (Fed. Cir. 1992), and In re Alappat, 33 F.3d 1526, (Fed. Cir. 1994).

Appellant's specification, yet fails to appreciate their significance. Appellant's specification notes that, with respect to step S.550, "[f]acilitating display could involve direct activity (e.g., displaying the templates) or indirect activity, such as providing access to software or any other form of indirect activity including the other forms discussed herein." Page 36, lines 5-8; emphasis added. The first clause in the body of claim 1 corresponds to page 38, lines 12-16, which describes step S.570. The specification clarifies, at page 38, lines 16-18, that "[a]s with the facilitating of S.550, the facilitating of S.570 may involve any direct or indirect activity, such as providing access to software for causing the display." Emphasis added.

The specification further explains that the terms "[e]nabling" and "facilitating" "refer to one or more of a direct act of performing the action, and any indirect act of encouraging or being an accessory to the action. Page 50, lines 6-8. For example, enabling may include "affiliating with an entity who performs the action" or "providing instructions, tools, or encouragement for another to do the accessing and displaying." Page 50, lines 21-23. In addition, at page 12, lines 11-17 the specification notes that

[e]nabling the image to be displayed may be accomplished in one or more of direct and indirect ways, including directly displaying the image on a display device, providing access to software that facilitates display, providing network access which enables display of the image on a user-controlled device, providing a dedicated use device, or cooperating with an entity who either directly displays the image or who helps the user to display the image.

Exemplary direct and indirect actions are further described as "for example . . . cooperating with a third party who aids a user, or . . . participating in any way in activities that aid a user" Page 13, lines 1-4; emphasis added.

Appellant respectfully points out that, as emphasized above, the definitions provided in the specification for both “facilitating” and “enabling” clarify that these terms involve activity, be it direct or indirect. Therefore, the method of claim 1 is more than a mere algorithm, abstract idea, or mental process. Accordingly, Appellant respectfully submits that claim 1 qualifies as a statutory process eligible for patenting under § 101.

In addition to the fact that claim 1 is directed to activity, Appellant respectfully submits that it is clear that the process recited in claim 1 is embodied in, operates on, transforms, or otherwise involves a machine and/or article of manufacture. In particular, claim 1 recites “facilitating display, on a display device, of a plurality of templates,” and “facilitating display, on a display device, of a simulated facial image.” Emphasis added. There is no question that the process of claim 1 involves a machine (e.g., the display device and any equipment associated therewith that contributes to the display of templates and images thereon). Furthermore, the process results in a transformation of the images displayed by the display device, since “the simulation of the displayed facial portion corresponds to a simulation of the at least one selected template,” (i.e., the displayed simulated facial image is transformed to correspond with the selected template(s).

Claim 1 relates to a method for enabling display of a simulated facial image and recites features that clearly produce a useful, concrete, and tangible result. For example, in claim 1, the recitations of “facilitating display . . . of a plurality of templates,” “enabling selection of at least one of the displayed templates,” and “facilitating display . . . of a simulated facial image,” provide a useful, concrete, and tangible result in the form of, for example, a simulated facial image that includes one or more displayed facial

portions having a simulation of use of a beauty product. This is a result that can be used in beauty analysis. Specification at 3.

For at least the foregoing reasons, Appellant respectfully submits that claim 1 is statutory under 35 U.S.C. § 101 and that, therefore, the rejection of claim 1 under 35 U.S.C. § 101 should be reversed.

The rejection of claims 1-11 and 13-21 under 35 U.S.C. § 102(e) should be reversed.

The Examiner has also interpreted Orpaz et al. (U.S. Patent No. 6,937,755; hereinafter "Orpaz") completely differently than in the final Office Action. In the final Office Action, the Examiner attempted to equate Figs. 12-18, which are the alpha values for various make-up application areas, with the "templates" recited in claims 1 and 18. See, e.g., final Office Action at 4. In the Examiner's Answer, however, the Examiner attempts to equate the central picture and category list in Fig. 3 with the "templates" recited in claims 1 and 18. See, e.g., Answer at 8. The Examiner also alleges that "because only some of the templates [in claim 1] are representative of a portion of a face having a simulation of use of a beauty product . . . , the selected template can be any one of said . . . central picture and category list [disclosed in Orpaz.]" Answer at 8.

Claim 1

Claim 1 recites, among other things,

facilitating display, on a display device, of a plurality of templates, wherein at least some of the templates are representative of a portion of a face having a simulation of use of a beauty product;

enabling selection of at least one of the displayed templates;
and

facilitating display, on the display device, of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product, wherein the displayed facial portion . . . corresponds to a facial portion of the at least one selected template, and wherein the simulation of the displayed facial portion corresponds to a simulation of the at least one selected template.

(Emphasis added.)

The Examiner is correct in his assessment that the first clause of claim 1 only requires some of the templates to be representative of a portion of a face having a simulation of use of a beauty product and that, therefore, enabling selection of at least one of the displayed templates in clause two does not necessarily, by itself, require enabling selection of a displayed template that is representative of a portion of a face having a simulation of use of a beauty product. However, the third clause of claim 1 specifies that the simulated facial image displayed includes "at least one displayed facial portion having a simulation of use of a beauty product" and further specifies that both the displayed facial portion and the simulation of the displayed facial portion "correspond to a simulation of the at least one selected template." Therefore, claim 1 clearly requires the simulated facial image (in the third clause of claim 1) to include a simulation of use of a beauty product that corresponds to the at least one selected template. Thus, the at least one displayed template for which selection is enabled (in the second clause of claim 1) necessarily must include a simulation of use of a beauty product.

Orpaz does not disclose enabling selection of a template representative of a portion of a face having a simulation of a beauty product. Neither the central image nor the category or subcategory lists in Fig. 3 constitute selectable templates representative of a portion of a face having a simulation of a beauty product. In the Orpaz system, a user selects a product from a database using an image simulation graphic interface. Col. 3, lines 27-61. With regard to Fig. 3, the Orpaz specification refers to category list 32 and subcategory list 34, but does not include any of reference numbers 32 or 34 in Fig. 3. However, it is presumed from context (see, e.g., col. 3, lines 34-40) that category list 32 refers to the circular icons to the far left of Fig. 3 labeled “Eyes,” “Lips & Face,” “Accessories,” “Nails,” etc. It is also apparent that subcategory list 34 refers to pop-up lists associated with each of the circular icons, such as the list in Fig. 3 including “Lipstick,” “Lip Gloss,” “Pencil,” etc. Orpaz does not disclose facilitating display of a simulated facial image including at least one displayed facial portion that corresponds to a facial portion of any of the items in category list 32 or subcategory list 34, nor does Orpaz disclose that the simulation of the displayed facial portion corresponds to a simulation of any of the items in category list 32 or subcategory list 34.

Instead, Orpaz discloses that once an item from category list 32 and a product from category list 34 are selected, a user may choose a color for the product using a color selection interface (CSI) 44. Col. 3, lines 54-58. Although not labeled in Fig. 3, it is apparent that CSI 44 refers to the horizontal row along the bottom left of Fig. 3, that is depicted as displaying five lipsticks, presumably of different colors. A user may choose one of the colors in CSI 44 and the system then simulates application of the selected product in the selected color on the base image 02. Id.

“To simulate the appearance of the selected product on the base image of the user, the color information of the selected product is modified and blended according to the color information of the base image to create a composite image.” Col. 6, line 66 - col. 7, line 3. For each base image, one or more make-up application areas are defined for each make-up product type and are assigned a separate alpha channel within the base image file. Col. 5, line 66-Col. 6, line 2.

At no time in the process, however, does Orpaz facilitate selection of a template representative of a portion of a face having a simulation of use of a beauty product or facilitate display of a simulated facial image including at least one facial portion corresponding to a facial portion of the selected template. Orpaz involves selection of products and colors thereof, not any template representative of a portion of a face having a simulation of use of a beauty product.

Appellant respectfully submits that, for at least the forgoing reasons, Orpaz does not disclose each and every element of independent claim 1.

Claim 18

For at least reasons similar to those discussed above, Orpaz also fails to disclose “viewing display, on a display device, of a plurality of templates . . . ; selecting at least one of the displayed templates; and viewing display, on the display device, of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product, wherein the displayed facial portion of the simulated facial image corresponds to a facial portion of the at least one selected template,” as recited in claim 18.

Orpaz does not disclose selecting at least one of a plurality of templates displayed on a display device and viewing display, on a display device, of a simulated facial image including at least one facial portion having a simulation of use of a beauty product that corresponds to a simulation of the at least one selected template. In particular, Orpaz does not disclose viewing display of a simulated facial image including at least one displayed facial portion that corresponds to a facial portion of any of the items in category list 32 or subcategory list 34, which the Examiner attempts to equate with the claimed templates, nor does Orpaz disclose that the simulation of the displayed facial portion corresponds to a simulation of any of the items in category list 32 or subcategory list 34. Orpaz involves selection of products and colors thereof, not selection of any template representative of a portion of a face having a simulation of use of a beauty product. Therefore, Orpaz fails to disclose all the recitations of independent claim 18.

For at least the foregoing reasons, Appellant respectfully submits that the 35 U.S.C. § 102(e) rejection of independent claims 1 and 18 and dependent claims 2-11, 13-17, and 19-21 should be reversed.

Conclusion

For the reasons presented in the Appeal Brief filed May 10, 2007, and the additional reasons outlined above, the Board is kindly requested to reverse all of the outstanding claim rejections, so that pending claims 1-21 may be allowed.

To the extent any extension of time is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due under 37

C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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